

REMARKS

The Office Action mailed May 18, 2006, has been received and reviewed. Claims 1, 3 through 12, 14, 15, 17 through 19, and 21 through 24 are currently pending in the application. Claims 1 through 24 stand rejected. Applicants have amended claims 1, 3 through 5, 12, 14, 15, 17 through 19, and 21, have canceled claims 2, 13, 16, and 20, and respectfully request reconsideration of the application as amended herein. Support for the amendments may be found throughout the as-filed specification and in the subject matter of claims 2, 13, 16, and 20 prior to cancellation. No new matter has been entered. The amendments and cancellations are made without prejudice or disclaimer.

35 U.S.C. § 112 Claim Rejections

Claims 15 through 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection; however, Applicants have removed “with an ink vehicle” from claims 15, 17, and 18. Claim 16 is canceled herein. Applicants assert that claims 15, 17, and 18 are clearly definite and request withdrawal of the 35 U.S.C. § 112, second paragraph rejection.

35 U.S.C. § 102 Anticipation Rejections

Anticipation Rejection Based on U.S. Patent 4,579,591 to Suzuki *et al.*

Claims 1, 2, 5 through 7, and 15 through 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Suzuki *et al.* (U.S. Patent No. 4,579,591) (hereinafter “Suzuki”). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to inherency, M.P.E.P. § 2112 provides:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) . . . ‘To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill . . .’ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1991).

Regarding independent Claims 1 and 15, Applicants assert that Suzuki does not describe, either expressly or inherently, each and every element of Claim 1 or Claim 15 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Suzuki does not describe the elements of the claimed invention calling for “[a] fixer fluid.” The Examiner asserted that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the alleged purpose or intended use, *i.e.*, fixer fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the compositions of the cited art. The “fixer fluid” element of Claim 1 and Claim 15 is necessary to “give, life, meaning, and vitality” to the claims. *See* M.P.E.P. § 2111.02. The phrase “fixer fluid” is necessary to define the subject matter of Claim 1 and Claim 15. It is within the context of a “fixer fluid” that the elements claimed in the body of the claim apply. The phrase “fixer fluid” as used in the claims “refers to a fluid that is substantially devoid of color and includes a reactive component (*e.g.*, a molecule, complex, or a functional group in a molecule, polymer, or complex) that reacts with a component of the inkjet ink.” *See, e.g.*, paragraph [0006] of the Specification. The phrase “fixer fluid” is necessary to understand what substance it is desirable to prevent precipitating the at least one cationic polymer out of. As Suzuki does not describe a “fixer fluid,” Suzuki does not anticipate Claim 1 or Claim 15.

The Examiner additionally asserted the solution of Suzuki would inherently possess reduced kogation and the phosphate ester would inherently not precipitate with the cationic polymer. No facts or reasoning have been presented as to why the desensitizing solution of Suzuki would necessarily have reduced kogation, or why the Suzuki phosphate ester would

necessarily not precipitate with the cationic polymers of Suzuki. Thus, for these additional reasons, Suzuki does not anticipate Claim 1 or Claim 15.

Regarding Claims 2 and 5-7, the claims depend from Claim 1 and, as such, adopt the recitations of Claim 1 via dependency therefrom. The failure of Suzuki to anticipate Claim 1 also precludes the anticipation rejection of the dependent claims. Thus, Suzuki does not anticipate Claims 2 and 5-7.

Regarding Claims 16 and 17, Claim 16 has been canceled. Claim 17 depends from Claim 15 and, as such, adopts the recitations of Claim 15 via dependency therefrom. The failure of Suzuki to anticipate Claim 15 also precludes the anticipation rejection of the dependent claim. Thus, Suzuki does not anticipate Claim 17.

Anticipation Rejection Based on U.S. Patent Publication 2004/0206274 to Kruckel

Claims 1, 2, 4 through 6, 15, 16, and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kruckel (U.S. Patent Publication 2004/0206274) (hereinafter “Kruckel”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Regarding independent Claims 1 and 15, Applicants assert that Kruckel does not describe, either expressly or inherently, each and every element of Claim 1 or Claim 15 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Kruckel does not describe the elements of the claimed invention calling for “[a] fixer fluid.” The Examiner asserted that the preamble does not state any distinct definition of any of the claimed invention’s limitations and, further, that the alleged purpose or intended use, *i.e.*, fixer fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the compositions of the cited art. For the reasons stated previously, the “fixer fluid” element of Claim 1 and Claim 15 is necessary to “give, life, meaning, and vitality” to the claims. *See* M.P.E.P. § 2111.02. As Kruckel does not describe a “fixer fluid,” Kruckel does not anticipate Claim 1 or Claim 15.

The Examiner additionally asserted that the solution of Kruckel would inherently possess reduced kogation and the phosphate ester would inherently not precipitate with the cationic polymer. No facts or reasoning have been presented as to why the paper-production solution of

Kruckel would possess reduced kogation, or why the Kruckel phosphate ester would not precipitate with the cationic polymers of Kruckel. Thus, for these additional reasons, Kruckel does not anticipate Claim 1 or Claim 15.

Regarding Claims 2 and 4-6, the claims depend from Claim 1 and, as such, adopt the recitations of Claim 1 via dependency therefrom. The failure of Kruckel to anticipate Claim 1 also precludes the anticipation rejection of the dependent claims. Thus, Kruckel does not anticipate Claims 2 and 4-6.

Regarding Claims 16 and 18, Claim 16 has been canceled herein. Claim 18 depends from Claim 15 and, as such, adopts the recitations of Claim 15 via dependency therefrom. The failure of Kruckel to anticipate Claim 15 also precludes the anticipation rejection of the dependent claim. Thus, Kruckel does not anticipate Claim 18.

Anticipation Rejection Based on U.S. Patent 4,176,107 to Buckman *et al.*

Claims 1, 2, 5, 15, and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Buckman *et al.* (U.S. Patent No. 4,176,107) (hereinafter “Buckman”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Regarding independent Claims 1 and 15, Buckman does not describe, either expressly or inherently, each and every element of Claim 1 or Claim 15 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Buckman does not describe the elements of the claimed invention calling for “[a] fixer fluid.” The Examiner asserted that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the alleged purpose or intended use, *i.e.*, fixer fluid, recited in the present claims does not result in a structural difference between the presently claimed invention and the compositions of the cited art. For the reasons stated previously, the “fixer fluid” element of Claim 1 and Claim 15 is necessary to “give, life, meaning, and vitality” to the claims. *See* M.P.E.P. § 2111.02. As Buckman does not describe a “fixer fluid,” Buckman does not anticipate Claim 1 or Claim 15.

The Examiner additionally asserted that the solution of Buckman would inherently possess reduced kogation and the phosphate ester would inherently not precipitate with the

cationic polymer. No facts or reasoning have been presented as to why the solution of Buckman would have reduced kogation, or why the Buckman phosphate ester would not precipitate with the cationic polymers of Buckman. Thus, for these additional reasons, Buckman does not anticipate Claim 1 or Claim 15.

Regarding Claims 2 and 5, the claims depend from Claim 1 and, as such, adopt the recitations of Claim 1 via dependency therefrom. The failure of Buckman to anticipate Claim 1 also precludes the anticipation rejection of the dependent claims. Thus, Buckman does not anticipate Claims 2 and 5.

Regarding Claim 16, Claim 16 has been canceled herein.

Anticipation Rejection Based on U.S. Patent 6,749,675 to Momose *et al.*

Claims 12 through 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Momose *et al.* (U.S. Patent 6,749,675) (hereinafter “Momose”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Regarding independent Claim 12, Applicants assert that Momose does not describe, either expressly or inherently, each and every element of Claim 12 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Claim 12 has been amended to recite a fixer fluid rather than an inkjet ink. Momose does not describe the elements of the claimed invention calling for “[a] fixer fluid.” As Momose does not describe a “fixer fluid,” Momose does not anticipate Claim 12.

Regarding Claims 13 and 14, Claim 13 has been canceled herein. Claim 14 depends from Claim 12 and, as such, adopts the recitations of Claim 12 via dependency therefrom. The failure of Momose to anticipate Claim 12 also precludes the anticipation rejection of the dependent claim. Thus, Momose does not anticipate Claim 14.

Anticipation Rejection Based on European Patent 0 499 425

Claims 12 through 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent 0 499 425 (hereinafter “EP 499425”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Regarding independent Claim 12, Applicants assert that EP 499425 does not describe, either expressly or inherently, each and every element of Claim 12 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Claim 12 has been amended to recite a fixer fluid rather than an inkjet ink. EP 499425 does not describe the elements of the claimed invention calling for “[a] fixer fluid.” As EP 499425 does not describe a “fixer fluid,” EP 499425 does not anticipate Claim 12.

Regarding Claims 13 and 14, Claim 13 has been canceled herein. Claim 14 depends from Claim 12 and, as such, adopts the recitations of Claim 12 via dependency therefrom. The failure of EP 499425 to anticipate Claim 12 also precludes the anticipation rejection of the dependent claim. Thus, EP 499425 does not anticipate Claim 14.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent Publication 2004/0063808 to Ma *et al.* in view of U.S. Patent 6,610,129 to Sader *et al.*

Claims 1-10 and 15-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ma *et al.* (U.S. Patent Publication 2004/0063808) (hereinafter “Ma”) in view of Sader *et al.* (U.S. Patent 6,610,129) (hereinafter “Sader”). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Regarding independent Claims 1 and 15, there is no suggestion or motivation to combine Ma with Sader to establish a *prima facie* case of obviousness regarding the invention of Claims 1 and 15 under 35 U.S.C. § 103(a). Ma appears to disclose a fixer fluid. *Office Action mailed May*

18, 2006, page 8. Sader appears to disclose an ink. *Id.* There is no motivation or suggestion in Sader to apply the disclosure of Sader to a fixer fluid. The only basis for such a combination would be impermissible hindsight based upon the Applicants' disclosure. Furthermore, knowledge in the art teaches away from such a modification or combination. As noted in paragraph [0008] of the as-filed Specification, "[m]any of the additives that have been used to improve the kogation of inkjet inks are not compatible with fixer fluids because the additives are anionic and, therefore, may precipitate with the cationic polymers." Claims 1 and 15 have been amended to recite "at least one anionic phosphate ester surfactant." One of ordinary skill in the art would not be motivated to combine the anionic surfactants of Sader with the cationic polymers of Ma, because of the possibility that the surfactants and polymers would precipitate together. Likewise, for the same reason it is also not inherent that a combination of Ma and Sader would not result in precipitation.

Additionally, if Ma is combined with Sader, then Ma will be drawn to an ink rather than a fixer fluid which would render Ma unsuitable for its intended purpose.

Therefore, for at least the above reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established.

Regarding Claims 2 through 10 and 15 through 18, Claims 2 and 16 have been canceled herein. Claims 3 through 10 depend from Claim 1 and, as such, adopt the recitations of Claim 1 via dependency therefrom. The non-obviousness of Claim 1 also precludes the obviousness rejection of the dependent claims. Thus, Claims 3 through 10 are non-obvious. Claims 17 and 18 depend from Claim 15 and, as such, adopt the recitations of Claim 15 via dependency therefrom. The non-obviousness of Claim 15 also precludes the obviousness rejection of the dependent claims. Thus, Claims 17 and 18 are non-obvious.

Obviousness Rejection Based on Ma in view of Sader, as applied to claims 1 through 10 and 15 through 18 above, and further in view of U.S. Patent Publication 2005/0155516 to Hermansky

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ma in view of Sader, as applied to claims 1 through 10 and 15 through 18 above, and further in view of

Hermansky (U.S. Patent Publication No. 2005/0155516) (hereinafter “Hermansky”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Hermansky does not overcome the shortcomings of Ma and Sader discussed above. Claim 11 depends from Claim 1 and, as such, adopts the recitations of Claim 1 via dependency therefrom. The non-obviousness of Claim 1 also precludes the obviousness rejection of the dependent claim. Thus, Claim 11 is non-obvious.

Obviousness Rejection Based on Ma in view of U.S. Patent Publication 2003/0103121 to Tomioka *et al.*

Claims 19-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ma in view of Tomioka *et al.* (U.S. Patent Publication 2003/0103121) (hereinafter “Tomioka”). Applicants respectfully traverse this rejection, as hereinafter set forth.

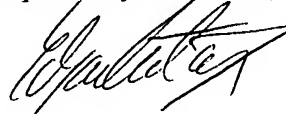
Regarding independent Claim 19, Applicant asserts that Ma and Tomioka, even if combined, do not teach or suggest all of the claim limitations of amended Claim 19 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Ma and Tomioka do not teach or suggest the claim limitation of the claimed invention calling for “wherein . . . the at least one phosphate ester surfactant is selected from the group consisting of a nonylphenol ethoxylate phosphate ester, a salt of a nonylphenol ethoxylate phosphate ester, a phosphated nonylphenoxy polyethoxy ethanol, organo phosphate, and a salt of ethyl-hexanol ethoxylated phosphate ester.” Therefore, for at least the above reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established.

Regarding Claims 20-24, Claim 20 has been canceled herein. Claims 21-24 depend from Claim 19 and, as such, adopt the recitations of Claim 19 via dependency therefrom. The non-obviousness of Claim 19 also precludes the obviousness rejection of the dependent claims. Thus, Claims 21-24 are non-obvious.

CONCLUSION

Claims 1, 3 through 12, 14, 15, 17 through 19, and 21 through 24 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Edgar R. Cataxinos
Registration No. 39,931
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: September 11, 2006
ERC/sfc:es
Document in ProLaw